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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
07/835,964	02/20/92	COATES	J IAF-14

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EXAMINER
FORD, J

ART UNIT	PAPER NUMBER
1611	43

DATE MAILED: 02/09/99

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 2-9-92 & 8-3-92

☒ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 23 and 25--42 is/are pending in the application.

Of the above, claim(s) 25, 26, 27, 33, 34, 36, 40 & 41 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 23, 28, 29, 30, 31, 32, 35, 37, 39, 39 and 42 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-848.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-848

☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

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Applicants' response of July 9, 1998, and August 3, 1998, are noted.

The claims in the application are claims 23 and 25-42.

The claims that have an additional active ingredient must be restricted out of this application; 37 CFR 1.145. They would not be of the same scope as the claims examined.

The *agreement* to examine method claims, only intends to methods of the same scope as the examined compounds.

This application is now found to contain claims to more than one invention, 37 CFR 1.141). Therefore, restriction is required under 35 USC 121.

(I) Claims 23,28,29,30,31,32,35,37,38,39 and 42 drawn to a method of using a compound of the presently searched invention.

(II) Claims 25,26,27,33,34,36,40 ~~41~~ drawn to method of using a compound of the present invention and another active ingredient.

These distinct inventions have acquired separate status in the art, will support separate patents, and will require different fields of search for the respective inventions. Accordingly, restriction for examination purposes as indicated is considered proper; 35 U.S.C. 121; 37 CFR 1.141; 37 CFR 1.142.

Applicants are constrained to elect Group I, claims 23,28,29,30,31,32,35,37,38,39 and 42, as this is the only invention that has been searched *here* in this old, many action, 07 series file. 37 CFR 1.145 prohibited the switching or addition of additional subject matter at this point in the prosecution.

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Applicants are considered to have elected Group I, by original presentation of claims; MPEP 821.03.

Accordingly, claims 25,26,27,33,34,36,40 and 41 stand withdrawn under 37 CFR 1.142(b).

Claims 23, and the claims dependent thereon, are rejected for the reasons of record, in paper No.37 of January 7, 1998.

Liotta '116 and Belleau '407 disclose this method, and are in District Court in Atlanta contesting the rights to the compound, and its use(s). See Emory University vs. Galaxo Wellcome, 44 USPQ (2nd) 1407.

Claims 23, 28,29,30,31,32,35,37,38,39 and 42 are rejected under 35 USC 103 as being unpatentable over Belleau '407. The present compounds are claimed in claim 10 of '407 and disclosed there in col.3, as an anti HIV agent.

Claims 23,28,29,30,31,32,35,37,38,39 and 42 are rejected under 35 USC 103 as being unpatentable over Liotta '116. The compound used here is disclosed for that utility in col.1. The Klibannov affidavit of 44 USPQ (2nd) pp 1413-14 contends Liotta '116 was in possession of the (-) enantiomer.

See the last office action, the prior art taken as a whole, indicates BCH-189 is useful in treating HIV, 37C is established as the enantiomer with the biological utility, see the previous Coates Article. Articles printed after the filing date, here, can be used to establish a fact, In re Wilson, 135 USPQ 442 at 444.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

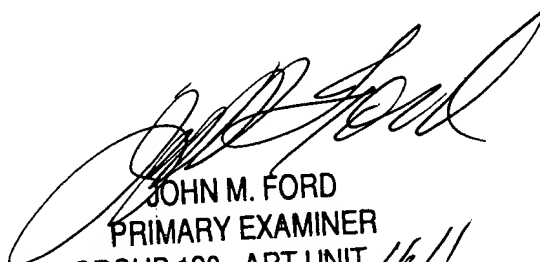
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

There is no need for a suspension action. Two patents have already issued which disclose this method.

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner J.M. Ford whose telephone number is (703) 308-1235.

Ford/sg

February 4, 1999


JOHN M. FORD
PRIMARY EXAMINER
GROUP ~~120~~ - ART UNIT 1611